

Appl. No. 09/992,454
Amdt. dated September 22, 2005
Reply to Office action of June 23, 2005

REMARKS/ARGUMENTS

Claims 2-8, 12 and 13 are pending in the application as set forth in the Amendment D filed December 2, 2004. Although communications were filed subsequently to the December 2, 2004 amendment, these subsequent communications did not amend the claims.

In this amendment, Claims 2-8 and 13 have been amended.

Claims 1 and 9-12 were previously canceled without prejudice to filing a continuation with respect thereto.

Claims 14-21 have been added.

As set forth below, the Claims as set forth above believed to be in condition for allowance. Reconsideration of the Application and issuance of a Notice of Allowability are respectfully requested.

Applicant notes that on May 16, 2005, a Notice of Allowance was issued in the present application. However, that Notice of Allowance was withdrawn on June 20, 2005 and the present office action was subsequently issued.

I. Rejections Under 35 U.S.C. §102

A. Watanabe et al. does not anticipate Claims 2, 5-8 or 12.

In the present office action, Claims 2, 5-8 and 12 have been rejected under 35 U.S.C. §102(b) as being anticipated by Watanabe et al. (Pat. No. 4363499). In order for a reference to anticipate a claim, the reference must show each and every element set forth

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in the claim. As discussed below, the Watanabe et al. patent lacks at least two (2) elements set forth in Claim 2, and hence does not anticipate Claim 2 or Claims 5-8 and 12 which depend therefrom.

Applicant notes that Claims 2-8, 12 and 13 have been amended to provide that the equipment is "playground" equipment, rather than "play and training" equipment. That the equipment is playground equipment is apparent from the first paragraph of the application, wherein the specification states: "The equipment is mainly intended to be used at playgrounds and the like ...". Hence, this amendment to the claims does not add new matter to the application.

Claim 1 as set forth comprises a "play unit adapted to be climbed upon" which is mounted to a "ground engaging post" by a "connector". Applicant notes that the Watanabe et al. patent lacks at least these elements. Applicant notes that the Watanabe et al. patent discloses a tiltable steering mechanism for automobiles. Watanabe et al. does not disclose a "play unit". The Examiner, in the rejection, appears to state that the automobile steering wheel corresponds to the "play unit" of Claim 2. While Applicant notes that steering wheels are sometimes incorporated into playground equipment, Applicant respectfully submits that the steering wheel of an operable automobile is not a play unit. Further, Watanabe et al. do not disclose a play unit which is "adapted to be climbed upon" as set forth in Claim 2; Watanabe et al. do not disclose a ground engaging post; and Watanabe et al. do not disclose a connector which mounts a play unit to a ground

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engaging post. Watanabe discloses a steering column, however, this steering column is not a ground engaging post. Watanabe also disclose a bearing assembly, which the Examiner asserts is a "connector". However, this bearing assembly mounts the column in a bracket, it does not mount the steering wheel (which the Examiner asserts corresponds to the play unit of Claim 2) to the steering column.

The specification provides at page 4 that the play unit can be a bridge or ladder. Hence the play unit is "adapted to be climbed upon". Additionally, the specification provides that the posts 1-3 "extend vertically from the ground". Hence, the amendments to Claim 2 do not add new matter.

Inasmuch as the Watanabe et al. patent does not teach at least the noted features, the Watanabe et al. patent cannot anticipate Claim 2. Claims 2-5 and 8 all depend from Claim 2, and hence are also not anticipated by Watanabe et al. Further, Claim 8 provides that the bushing "comprises discrete elements spaced about said shell." While Watanabe et al. disclose that the bearing assembly includes a "bush" (sic), Watanabe et al. do not disclose that this "bush" comprises discrete elements. Thus, Claim 8 is also not anticipated by Watanabe et al. for at least this additional reason.

At best, the Watanabe et al. patent can be used to reject the Claims under 35 U.S.C. §103. However, as set forth below, the Watanabe et al. patent does not make obvious the invention of Claim 2.

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B. Watanabe et al. is not analogous prior art.

To rely on a reference under 35 U.S.C. §103, it must be analogous prior art. MPEP 2141.01(a). The Watanabe et al. patent is not analogous prior art. The MPEP at §2141.01(a) provides that:

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved)."

The Watanabe et al. patent fails both tests. As noted above, the Watanabe et al. patent is directed to a tiltable steering mechanism for an automobile while Applicant's invention is related to playground equipment, and in particular a connector for mounting a play unit of the playground equipment to a post of the playground equipment. Hence, the Watanabe et al. reference is not in Applicant's field of endeavor. As noted in the MPEP, a reference can be analogous even if not in the same field of endeavor. However to be analogous, the reference is reasonably pertinent because of the matter with which it deals,

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must logically have commended itself to an inventor's attention in considering his problem. However, the Watanabe et al. patent is so far a field from Applicant's endeavor that it would not have "commended itself to an inventor's attention in considering his problem. *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

Thus, the Watanabe et al. patent (1) is not in Applicant's field of endeavor and (2) is not reasonably pertinent to the problem being solved by Applicant. The Watanabe et al. reference therefore is not analogous prior art, and Applicant therefore requests that the Watanabe et al. patent be withdrawn as a reference against the claims.

C. Watanabe et al. does not make Claims 2, 5-8 or 12 obvious.

Even if Watanabe et al. is retained as a reference, it does not make obvious the invention of Claim 2, or Claims 5-8 and 12 which depend from Claim 2.. In particular, Watanabe et al. does not teach or suggest (1) a playground assembly; (2) a play unit adapted to be climbed upon and which is mounted to a post; or (3) a connector that mounts that play unit to the post and enables "a limited and dampened swinging motion." With respect to the last noted element, Watanabe et al. discloses that an intermediate shaft (5) of the steering assembly is rotatably supported through a bearing assembly (13) on a bracket 12, as seen in FIG. 3.

Claim 2 provides that the connector mounts the play unit to the post. If the bearing assembly 12 is considered the connector, if the steering wheel is considered to be a play unit, and if the column 5 is considered to be the post, then the Watanabe et al. "connector"

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does not mount the steering wheel (i.e., the purported play unit) to the post, rather, it mounts the post in a bracket.

As seen in FIG. 3 of Watanabe et al., the bearing 13 comprising a "rubber bush 13a and a bearing 13b disposed in the rubber bush 13a." Watanabe et al. teach only that the bearing assembly 13 will rotationally connect or mounts the steering column part 5 in the bracket 12. Watanabe et al. do not teach or suggest that the bearing assembly 13 will allow for a "limited and dampened swinging movement" of the steering wheel about the post as set forth in Claim 2.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP §2142. The Watanabe et al. reference fails on each of these three points.

Watanabe et al. does not suggest or motivate one of ordinary skill in the art to modify the reference. Modification of Watanabe et al. would require that the bearing assembly 13 be moved so that the bearing assembly connects the steering wheel 4 to the

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shaft 5, and the bearing assembly 13 would need to be modified to allow for a limited and dampened swinging motion. Applicant respectfully submits that if the Watanabe et al. steering assembly were modified in such a manner, it would be inoperative. First of all, the steering column 5 would no longer easily rotate in the bracket 12. Additionally, the connection of the steering wheel to the column 5 would make use of the steering wheel difficult. Thus, Applicant respectfully submits that there can be no expectation of success that the modification of Watanabe et al. will work. Lastly, as noted above, Watanabe et al. is missing several elements set forth in Claim 2.

For at least the foregoing reasons, Watanabe et al. does not make Claim 2 obvious. Claims 5-8 and 12, as noted above, depend from Claim 2 and thus are not made obvious by Watanabe et al. Additionally, with respect to Claim 8, Watanabe et al. do not disclose a bushing made of discrete parts. Hence, for this additional reason, Watanabe et al. do not make obvious in subject matter of Claim 8.

D. Conclusion as to Rejections Under 35 U.S.C. §102

For at least the foregoing reasons, Watanabe et al. does not anticipate Claims 2, 5-8 or 12. Further, Watanabe et al. is not analogous prior art and should be withdrawn as a reference. If Watanabe is maintained as a reference, then Watanabe et al. does not make obvious the invention of Claims 2, 5-8, or 12.

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II. Rejections Under 35 U.S.C. §103

Claims 3-4 and 13 were rejected under 35 U.S.C. §103 as being unpatentable over Watanabe et al. in view of Land (Pat. No. 4815331). Claims 3-4 and 13 depend from Claim 2 and further define the construction of the play unit (Claims 3 and 4) and the location of the connector (Claim 13).

A. Watanabe et al. and Land are not analogous prior art

As noted above, Watanabe et al. is not analogous prior art. Land is similarly non-analogous prior art. Land is directed to a right hand steering wheel for an automobile. Land is thus in a field of art which is substantially removed from Applicant's endeavor. Further, because of the matter with which it deals (i.e., automobile steering wheels), the Land patent would not logically have commended itself to an inventor's attention in considering his problem (i.e., designing the connection of play units to support posts of playground equipment). Hence, like Watanabe et al., Land fails both the tests for analogous prior art. Inasmuch as Land is not analogous prior art, Applicant respectfully requests that the Land patent be removed as a reference against Applicant's claimed invention.

B. The Combination of Land and Watanabe et al. do not make obvious the claimed invention

As with Watanabe et al., in the Office Action, the Examiner asserts that the steering wheel of Land corresponds to Applicant's play unit. For the reasons noted above in the discussion of the Watanabe et al. reference, Applicant respectfully asserts that the

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steering wheel of an operative automobile is not a play unit. Further, even if the steering wheel were considered to be a "play unit" the combination of Land and Watanabe would result in the tiltable steering assembly of Watanabe with an oval shaped steering wheel. As discussed above, Watanabe et al. do not teach or suggest the invention of Claim 2. Hence, the combination of Watanabe et al. and Land do not teach or suggest the invention of Claims 3, 4 or 13, all of which depend from Claim 2. Claims 3, 4 and 13 are thus not made obvious by the combination of Watanabe et al. and Land and are allowable over the combination of Watanabe et al. and Land.

III. New Claims

New Claims 14-21 have been added. Independent Claim 14 is directed to play/exercise equipment comprising a play unit adapted to be climbed upon. As set forth in Claim 14, the play unit is adapted to be climbed upon and includes a frame which a support shaft extending from at least one end thereof. The frame is comprised of a pair of opposed side members and a plurality of cross-members extend between the side members. A mounting shaft extends from at least one end of the play unit. The play unit is mounted to a ground engaging support post by means of a connector which receives the play unit mounting shaft. The connector allows for a limited and dampened swinging movement around an imaginary axis between the opposite ends of the play unit.

Claims 15-18 define various aspects of the play unit itself and Claims 19-21 define various aspects of the connector.

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The subject matter of the new claims is shown in the drawings, described in the specification, or otherwise set forth in the originally filed claims. Hence, the addition of Claims 14-21 does not add new matter to the application.

None of the references of record, whether considered individually or in combination, are believed to teach or suggest the invention of Claim 14. Hence, Claim 14 is believed to be allowable. Claims 15-21 depend from Claim 14 are thus similarly believed to be allowable.

In view of the foregoing, Claims 2-8 and 13-21 are believed to be in condition for allowance. A Notice of Allowability with respect to these claims is thus respectfully requested.

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Respectfully Submitted,


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